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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,210	05/30/2001	Scott Wolinsky	IT/02	7821

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ANATOLY S. WEISER, ESQ
674 VIA DE LA VALLE
SUITE 216
SOLANA BEACH, CA 92075

EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,210	WOLINSKY, SCOTT	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/2003, 1/22/04, and 5/5/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-154 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5,6,12,14-16,21,22,28,30-32,38-40,42-44,50-52,54-80,86,87,90,92-94,100,101,104 and 106-108.

Continuation of Disposition of Claims: Claims rejected are 1-4,7-11,13,17-20,23,25-27,29,33-37,41,45-49,53,81-85,88,89,91,95-99,102,103,105 and 109-154.

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment and responses filed on October 20, 2003, January 22, 2004, and May 5, 2004, respectively. Applicant amends claims 13, 29, 41, 53, 91, and 105, adds new claims 109-154, amends the specification, and responds to the claim rejections.

Drawings

2. Regarding figures 3-5 and 7-8, color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

3. In order to avoid abandonment, the drawing informalities noted in Paper No.'s 6, mailed on July 25, 2003, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99 are rejected under 35 U.S.C. 102(a) as being anticipated by Online MONOPOLY®.

Online MONOPOLY® discloses the traditional game of MONOPOLY® played online by one or more players connected to the game website via personal computers. Online MONOPOLY® discloses:

Regarding Claims 1, 2, 17, 18, 33, 35, 45, 47, 48, 81, 82, 83, 95, 96, and 97:

- inputting at one of a plurality of communication terminals (player's personal computer) connected via a communications link (typically a phone line), an instruction (click the roll dice button) to determine an outcome (determine how many spaces a player's token will be moved); and
- randomly determining at said one terminal (roll dice), a signal representing said outcome to send to each of said terminals for display (the player's token will be highlighted and moved on the screen).

Regarding Claims 3, 4, 19, 20, 36, 37, 49, 84, 85, 98, and 99:

- said displayed outcome simulates a game accessory (simulated die).

Regarding Claims 7 and 23:

- said signal is an inband signal transmitted over said communications link. The game data downloaded to a player's personal computer is an "inband" signal.

Regarding Claims 9, 25, 33, and 45:

- defining a plurality of identifiers (player's token) use to differentiate between said terminals;
- determining at each of said terminals, from which terminal said signal originated (when it is a player's turn, their respective token will be highlighted and moved upon clicking the roll dice button); and
- indicating at each of said terminals, said outcome and originating terminal identifier (player's token moves upon clicking the roll dice button).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 11, 24, 27, 34, 46, 89, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY®.

Online MONOPOLY® discloses that as discussed above regarding claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99. Online MONOPOLY® seems to lack explicitly disclosing:

Regarding Claims 11, 27, 34, and 46:

- each identifier is represented by a different color emitted by one or more LED's.

Regarding Claims 89 and 103:

- the displayed outcome enables a game player to indicate a bet.

Regarding Claims 8 and 24:

- the inband signal comprises at least one dual tone multi-frequency signal.

Regarding claims 11, 27, 34, and 46, to one having ordinary skill in the art at the time of applicant's invention, it would have been obvious to represent each player token with a different color. One would be motivated to do so because this would enhance the graphics on the display screen and make it easier for player's to distinguish between game tokens.

Regarding claims 89 and 103, to one having ordinary skill in the art at the time of applicant's invention, it would have been obvious for a player to place a bet based on the outcome of the die before each turn. One would be motivated to do so because this would provide a side game making the main game more exciting.

Regarding Claims 8 and 24, to one having ordinary skill in the art at the time of applicant's invention, it would have been obvious to play Online MONOPOLY® over a computer network connection via a standard modem which sends and receives dual tone multi-frequency signals upon connecting to an Internet provider's server. One would be motivated to do so because this is a conventional way to play online games.

8. Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Teshima et al. (U.S. 5,273,288).

Online MONOPOLY® discloses that as discussed above regarding claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99. However, Online MONOPOLY® seems to lack explicitly disclosing:

Regarding Claims 10 and 26:

- conversing parties associated with said terminals can spontaneously set up and play a game without interfering with an ongoing conversation over said communications link.

Teshima et al., like Online MONOPOLY®, teaches of game(s) that can be played over a communications line, such as, a telephone line. Therefore, Online MONOPOLY® and Teshima et al. are analogous art. Furthermore, Teshima et al. teaches each player has a game board that is connected to a telephone line such that one player can play a game against another player in real-time over a telephone line. Teshima et al. additionally teaches:

Regarding Claims 10 and 26:

- conversing parties associated with said terminals can spontaneously set up and play a game without interfering with an ongoing conversation over said communications link (column 3, lines 10-21).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Teshima's communication feature in Online MONOPOLY®. One would be motivated to do so because enabling players to converse during the game makes the game more entertaining and personally interactive.

9. Claims 88 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of McKay et al. (U.S. Pub. 2002/0082067).

Online MONOPOLY® discloses that as discussed above regarding claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99. However, Online MONOPOLY® seems to lack explicitly disclosing:

Regarding Claims 88 and 102:

- the displayed outcome simulates a timer.

Mckay et al. teaches of a trivia board game played on a personal computer. Mckay et al. and Online MONOPOLY® are analogous art since both teach of board games that are played on personal computers. Mckay et al. teaches:

Regarding Claims 88 and 102:

- the displayed outcome simulates a timer (13) (fig. 1).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Mckay's timer in Online MONOPOLY®. One would be motivated to do so to place a limit on the amount of time a player has to decide whether to purchase a property the player has landed on during their turn.

10. Claims 13, 29, 41, 53, 91, 105, and 109-113, 115-121, 123-125, 127-132, 134-139, and 141-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Eck et al. (U.S. Pub. 2002/0045484).

Online MONOPOLY® discloses that as discussed above regarding claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99. However, Online MONOPOLY® seems to lack explicitly disclosing:

Regarding Claims 13, 29, 41, 53, 91, and 105:

- at least one of the terminals is a wireless telephone.

Eck et al., like Online MONOPOLY®, teaches playing games over a network. Therefore, Eck et al. and Online MONOPOLY® are analogous art. In particular, Eck et al.

teaches of implementing GAME BOY® video games and other applications in a cellular telephone. Eck et al. teaches:

Regarding Claims 13, 29, 41, 53, 91, and 105:

- at least one of the terminals is a wireless telephone (paragraph 19).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to play MONOPOLY® on a wireless telephone. One would be motivated to do so because this would allow a player to play the game on subways, at sports arenas, after school, and in a number of other contexts.

11. Claims 114, 122, 126, 133, and 140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Eck et al. (U.S. Pub. 2002/0045484) and further in view of Teshima et al. (U.S. 5,273,288).

Online MONOPOLY® in view of Eck et al. teaches that as discussed above regarding claims 13, 29, 41, 53, 91, 105, and 109-113, 115-121, 123-125, 127-132, 134-139, and 141-154. However, Online MONOPOLY® in view of Eck et al. seems to lack explicitly teaching:

Regarding Claims 114, 122, 126, 133, and 140:

- conversing parties associated with said terminals can spontaneously set up and play a game without interfering with an ongoing conversation over said communications link.

Teshima et al., like Online MONOPOLY®, teaches of game(s) that can be played over a communications line, such as, a telephone line. Eck et al. teaches of implementing GAME BOY® video games and other applications in a cellular telephone. Therefore, Online MONOPOLY®, Eck et al., and Teshima et al. are analogous art. Furthermore, Teshima et al.

teaches each player has a game board that is connected to a telephone line such that one player can play a game against another player in real-time over a telephone line. Teshima et al. additionally teaches:

Regarding Claims 114, 122, 126, 133, and 140:

- conversing parties associated with said terminals can spontaneously set up and play a game without interfering with an ongoing conversation over said communications link (column 3, lines 10-21).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Teshima's communication feature in Online MONOPOLY® in view of Eck et al. One would be motivated to do so because enabling players to converse during the game makes the game more entertaining a personally interactive.

Response to Arguments

12. Applicant's arguments filed on October 20, 2003, January 22, 2004, and May 5, 2004 have been fully considered but they are not persuasive.

13. The examiner notes Applicant's representative indicates a brief telephone interview was conducted on October 14, 2003. However, a formal interview was not conducted in this application.

14. Applicant's arguments, see pages 2, 3, and 23, filed October 20, 2003, with respect to the objection to the specification has been fully considered and is persuasive. The objection to the specification has been withdrawn.

15. Applicant respectfully traverses the rejection to claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99 under 35 U.S.C. 102(a) as being anticipated by Online

MONOPOLY®. Applicant alleges Online MONOPOLY® is not prior art because there is no indication that the code of this version was available to the public on a date prior to filing of the instant application. The examiner respectfully disagrees. In addition to the date of the source code of the playsite.com's Online MONOPOLY® rules page (not the source code for the game as indicated by Applicant in the response), the examiner submits the Online MONOPOLY® game was released at least as early as 2000 as demonstrated by the GameSpy.com-Gaming Profile newly cited by the examiner.

Additionally, Applicant alleges Online MONOPOLY® does not anticipate the limitation "the signal is determined at one said terminal" and not at the game server. The examiner respectfully disagrees. The Online MONOPOLY® software resides on a game player's personal computer, therefore, the signal is determined (or at least initiated) at a player's personal computer, rather than at a central server.

For the reasons discussed hereinabove, the examiner maintains the rejection to claims 1-4, 7, 9, 17-20, 23, 25, 33, 35-37, 45, 47-49, 81-85, and 95-99 under 35 U.S.C. 102(a) as being anticipated by Online MONOPOLY®.

16. Applicant respectfully traverses the rejection to claims 8, 11, 24, 27, 34, 46, 89, and 103 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY®.

Applicant alleges claims 8, 11, 24, 27, 34, 46, 89, and 103 are allowable for the same reasons explained in relation to the section 102 rejection. The examiner respectfully disagrees. Please see item No. 14.

Regarding claims 11, 27, 34, and 46, Applicant alleges representing an identifier by a different color emitted by an LED is not rendered obvious by Online MONOPOLY®.

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Particularly, Applicant alleges utilizing the graphics in Online MONOPOLY® to enhance the graphics on the display screen (such as different color tokens) to make it easier for players to distinguish between game tokens does not render the claim limitation obvious. The examiner respectfully disagrees. The function of the LED's and the graphics on the display screen is the same. That is, to represent each player's game token in a different color.

Regarding claims 8 and 24, applicant alleges a DTMF signaling technique is not used to transmit game outcome signals via modem connections. As previously pointed out in Office Action, Paper No. 6, it would have been obvious to play Online MONOPOLY® over a computer network connection via a standard modem which sends and receives dual tone multi-frequency signals upon connecting to an Internet provider's server. One would be motivated to do so because this is a conventional way to play online games. When a player connects to an Internet Service Provider via a modem on a telephone line, a telephone number is dialed using the signaling technique to connect to the telephone company central office as described by Applicant on page 26 of the reply.

For the reasons discussed hereinabove, the examiner maintains the rejection to claims 8, 11, 24, 27, 34, 46, 89, and 103 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY®.

17. Applicant respectfully traverses the rejection to claims 13, 29, 41, 53, 91, and 105 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Eck et al. (U.S. Pub. 2002/0045484). Applicant alleges Eck does not teach establishing wireless links between communications terminals (such as wireless telephones) and transmitting a game signal over the wireless link. The examiner respectfully disagrees. Eck et al. clearly teaches this limitation

throughout the reference. Please see the Abstract, and paragraphs 19 and 106. For the reasons discussed hereinabove, the examiner maintains the rejection to claims 8, 11, 24, 27, 34, 46, 89, and 103 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Eck et al. (U.S. Pub. 2002/0045484).

18. Regarding the rejection to claims 10 and 26 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of Teshima et al. (U.S. 5,273,288), Applicant alleges claims 10 and 26 are allowable for the same reasons explained in relation to the section 102 rejection. The examiner respectfully disagrees. Please see item No. 14.

19. Regarding the rejection to claims 88 and 102 under 35 U.S.C. 103(a) as being unpatentable over Online MONOPOLY® in view of McKay et al. (U.S. Pub. 2002/0082067), Applicant alleges claims 88 and 102 are allowable for the same reasons explained in relation to the section 102 rejection. The examiner respectfully disagrees. Please see item No. 14.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEJ
sej

JOHN M. HOTALING, II
PRIMARY EXAMINER